



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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R2000-117

DEC 13 2000

In re

DECISION ON
PETITION FOR REGRADE
UNDER 37 C.F.R. § 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading questions 7, 16, 18, 19, 39, 44, and 49 of the morning section and questions 1, 10, 16, and 28 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 64. On July 31, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded two points for morning questions 19 and 44. Accordingly, petitioner has been granted additional two points on the Examination. However, no credit has been awarded for morning questions 7, 16, 18, 39 and 49 and afternoon questions 1, 10, 16 and 28. Petitioner's arguments for these questions are addressed individually below.

Morning question 7 reads as follows:

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

Claim 1. An apparatus for shearing sheep, said apparatus comprising:

(i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;

(ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;

(iii) _____;

(iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.

Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.

Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

(A) "wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and"

(B) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(C) "said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends, said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(D) "said first cutting member and said second cutting member being pivotally secured to each other by a connector; and"

(E) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and"

The model answer is choice (B).

Answer (B) provides proper antecedent basis for "said mid-point" in part (iv) of Claim 1 and in Claim 2, and "said connector" in Claim 3. Answer (A) is incorrect at least because it does not provide antecedent basis for "said connector" in Claim 3. Answer (C) is narrower than Answer (B) because it includes the additional limitation of a reservoir and therefore does not "most broadly" complete claim 1. Answer (D) is incorrect because it does not provide proper antecedent basis for "said mid-point" in part (iv) of Claim 1 and in Claim 2. Answer (E) is incorrect because it does not provide antecedent basis for "said connector" in Claim 3.

Petitioner argues that none of the answers is correct and answer (D) is the best given that the question did not ask about 35 U.S.C. § 112. Petitioner argues that answer (D) is more broad than answer (B). Petitioner contends that answer (B) fails to provide antecedent basis for "said mid-point" in (iv) and is therefore incorrect. Petitioner concludes that all answers are incorrect and maintains that answer (B) is incorrect and therefore credit should be given for the most broad among all answers.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (B) fails to provide antecedent basis for "said mid-point" in (iv) and is therefore incorrect, the question in (iv) specifically states "said second cutting member additionally including a pointer loop between said finger loop and said mid-point". As explained in answer (B), each of the first and second cutting means has a mid-point. Accordingly, answer (B) provides antecedent basis for the second cutting means mid-point in (iv), rendering the statement in answer (B) correct. As to petitioner's argument that the question did not specifically

ask about claims that fail to satisfy 35 USC § 112, the instructions state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. Because answer (B) is correct, no incorrect answer, including answer (D), can be the most correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 16 reads as follows:

16. A patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure in the specification of the minimum amount of storage for the random access memory. In the disclosed preferred embodiment, the microprocessor has a clock speed of 100-200 megahertz. Claims 9 and 10, presented below, are original claims in the application. Claim 11, presented below, was added by amendment after an Office action.

9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.

10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.

11. The personal computer of Claim 10, wherein the random access memory is greater than ½ gigabyte of storage.

Which of the following statements is or are true about the respective claims under 35 U.S.C. § 112, fourth paragraph?

(A) Claim 9 is a proper independent claim, and Claims 10 and 11 are proper dependent claims.

(B) Claim 9 is a proper independent claim, and Claims 10 and 11 are improper dependent claims.

(C) Claim 9 is an improper independent claim, and Claims 10 and 11 are improper dependent claims.

(D) Claim 9 is an improper independent claim, and Claims 10 and 11 are proper dependent claims.

(E) Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

The model answer is choice (E).

(E) is the most correct answer. Claim 9, though broad, is supported by the specification. The minimum memory recited in the claim as original disclosure, is self-supporting. 35 U.S.C. § 112, first paragraph. Claim 10 is a proper dependent claim because it depends from and further restricts the scope of a preceding claim. 37 C.F.R. § 1.75(c). Claim 11 is an improper dependent claim because it expands upon, as opposed to further restricts, the scope of claim 10. Claim 10, depending on Claim 9, has a 1 gigabyte memory minimum, whereas Claim 11 expands upon the minimum memory by setting a lower minimum of ½ gigabyte.

Petitioner argues that answer (A) is the most correct. Petitioner contends that because claim 9 fails to satisfy 35 U.S.C. § 112, claim 9 cannot be correct and claims 10 and 11 must also be incorrect, making answer (C) the best answer. Petitioner argues that the best answer is therefore questionable making answer (A) the best answer. Petitioner does not indicate the rationale for selecting answer (A) as the best answer. Petitioner concludes that answer (E) is incorrect and maintains that answer (A) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that claim 9 fails 35 U.S.C. § 112, the question specifically restricts its scope to matters of 35 U.S.C. § 112, fourth paragraph. Claim 9, as an independent claim, is proper under 35 U.S.C. § 112, fourth paragraph. Of the two dependent claims, only claim 11 is improper under 35 U.S.C. § 112, fourth paragraph. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 18 reads as follows:

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?
- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
 - (B) Favoring the prompt and widespread disclosure of inventions.
 - (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
 - (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
 - (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

The model answer is choice (D).

Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996).

Petitioner argues that (C) is the best answer. Petitioner contends that answer (C) deals with sales and is therefore not a policy underlying a public use bar and that (C) is an unusable factor because it is difficult to quantify. Petitioner concludes that answer (D) is incorrect and maintains that answer (C) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that sales are not a policy factor underlying a public use bar, sales are a form of public use and therefore are part of a policy factor underlying a public use bar. As to the argument that sales are difficult to quantify, the opposite is most true, because sales are reported by sellers. Petitioner does not argue that (B) is not a correct answer. Petitioner's argument that answer (C) is not a factor underlying such policy is negated by the holding in *Lough v.*

Brunswick Corp., which states "[w]e have defined 'public use' as including 'any use of [the

claimed] invention by a person other than the inventor who is under no limitation, restriction or obligation of secrecy to the inventor." *In re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983) (citing *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881)). An evaluation of a question of public use depends on "how the totality of the circumstances of the case comports with the policies underlying the public use bar." *Tone Bros. v. Sysco Corp.*, 28 F.3d 1192, 1198, 31 USPQ2d 1321, 1324 (Fed. Cir. 1994), cert. denied, 115 S. Ct. 1356 (1995). These policies include: (1) discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available; (2) favoring the prompt and widespread disclosure of inventions; (3) **allowing the inventor a reasonable amount of time following sales activity to determine the potential economic value of a patent**; and (4) prohibiting the inventor from commercially exploiting the invention for a period greater than the statutorily prescribed time." The statement in answer (D) is the only statement not included among the enumerated factors and is therefore correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists _____

- (A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.

(C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.

(E) None of the above.

The model answer is choice (C).

Selection (C) is the most correct as per MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: "No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent." (E) is incorrect because a (C) is correct.

Petitioner argues that none of the answers (A) through (D) are correct. Petitioner contends that broadening a limitation added during reissue nevertheless narrows the claim relative to the original claim and narrowing the claim is not impermissible recapture. Petitioner concludes that answer (E) is correct as declaring that the other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that broadening a limitation added during reissue nevertheless narrows the claim relative to the original claim and narrowing the claim is not impermissible recapture, the question specifically states that impermissible recapture exists if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application. As explained in the instructions, do not assume any additional facts not presented in

the questions. Accordingly, the question does not state that such limitation is added during reissue, only that the limitation is broadened during reissue, rendering such broadening impermissible recapture. The statement in answer (C) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 49 reads as follows:

49. Which of the following statements is NOT true?

(A) In representation of a client, a patent practitioner may not refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful so long as there is some support for an argument that the conduct is legal.

(B) A patent practitioner may not form a partnership with a non-practitioner if any of the activities of the partnership consists of the practice of patent law before the PTO.

(C) In a patent case, a practitioner may take an interest in the patent as part or all of his or her fee.

(D) If a practitioner receives information clearly establishing that a client has, in the course of representation, perpetrated a fraud on the PTO that the client refuses or is unable to reveal, the practitioner must reveal the fraud to the PTO.

(E) A patent practitioner may not accept compensation from a friend of a client for legal services performed by the practitioner for the client, unless the client consents after full disclosure.

The model answer is choice (A).

37 C.F.R. § 10.84(b)(2) specifies that a practitioner may refuse to aid or participate in conduct the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal. Thus, statement (A) is FALSE. Statement (B) is TRUE. 37 C.F.R. § 10.49. Statement (C) is TRUE. 37 C.F.R. § 10.64(a)(3). Statement (D) is TRUE. 37 C.F.R. § 10.85(b)(1). Statement (E) is TRUE. 37 C.F.R. § 10.68(a)(1).

Petitioner argues that answers (B) and (D) are correct because their statements are false.

Petitioner contends that because multiple answers are correct, all answers should be given credit.

Petitioner does not argue that his selected answer (C) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answers (B) and (D) are false, statements in answers (B) thru (E), including petitioner's answer (C), are true and therefore these answers are incorrect. See 37 CFR 10.49, 10.64(a)(3), 10.85(b)(1), and 10.68(a)(1). No error in grading has been shown.

Petitioner's request for credit on this question is denied.

Afternoon question 1 reads as follows:

1. Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

(A) In a utility case, gross sales figures accompanied by evidence as to market share.

(B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.

(C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.

(D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.

(E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

The model answer is choice (D).

(D) is correct because gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence

in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing commercial success to the design of the device, rather than the utilitarian function of the device. MPEP 716.03(b).

Petitioner argues that more than one of the answers is correct and therefore all answers should be marked as correct. Petitioner argues that answers (A), (B) and (C) are correct because gross sales are factors to consider rather than probative evidence. Petitioner does not argue that his answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that because more than one answer is correct, all answers should be marked as correct, the instructions specifically states that there is only one most correct answer for each question. An incorrect answer cannot be a most correct answer where at least one correct answer is shown. Petitioner has not argued that his answer is correct, and therefore his answer remains indicated as incorrect. As to petitioner's argument that (A), (B) and (C) are correct because gross sales are factors to consider rather than probative evidence, it is pointed out that factors to consider constitute an example of probative evidence. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client. Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian

reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues that none of the answers is correct and answer (D) is the at least a good answer among the incorrect answers as any. Petitioner contends that Sam must file something because the claims 2-10 are incomplete because they depend from canceled claim 1. Petitioner does not argue that answer (D) is best.

Petitioner's argument has been fully considered but is not persuasive. Answer (D) is incorrect because there are no divisional reexaminations. Contrary to petitioner's statement that Sam must file something because the claims 2-10 are incomplete because they depend from canceled claim 1, no action is required. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required as per MPEP § 2260.01. Rewriting patentable dependent claims in independent form in a reexamination proceeding is not required. As the original patent claim numbers are not changed in a reexamination proceeding, the content of the canceled base claim would remain in the printed patent and would be available to be read as part of the allowed dependent claim. See MPEP 2260.01. The statement in answer (B) is correct and the statement in answer (D) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1,

1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B).

Selection (B) is correct as per *The International Glass Company, Inc. v. United States*, 159 USPQ 434 (US Cl Ct, 1968); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988); *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

Petitioner argues that none of the answers is correct. Petitioner contends that the cases cited are not appropriate applications to the question in light of a purported omission in the MPEP on the

examined point. Petitioner argues that the silence in the MPEP on the question of whether near simultaneous invention is evidence of level of skill is proof that the cited cases are not applicable. Petitioner concludes that answer (B) is incorrect and maintains that answer (E) is correct because it is the only answer indicating all other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. As indicated in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. The cases cited above are clearly applicable on the issue of whether nearly contemporaneous invention is evidence of the level of skill in the art. The MPEP revisions are merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law.

The *Merck* case stated at 380, "[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of 'the level of knowledge in the art at the time the invention was made.' *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983)." *Monarch Knitting* stated "[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art" at 1983, referring to *Merck*. Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention, rendering the statement in answer (B) correct and therefore answer (E) incorrect because (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is **true**?

- (A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.
- (B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).
- (C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.
- (D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.
- (E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E).

Selection (E) is correct. See MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 CFR 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. MPEP 1206, pages 1200-8 and 9. As to (B), see MPEP 1002 and the sentence bridging pages 1000-2 and 1000-3. As to (C), 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. As to (D), continuation may be filed during pendency of parent.

Petitioner argues that answer (C) is correct. Petitioner contends that answer (E) is incorrect because there is no requirement to claim foreign priority in the declaration or oath and that answer (C) is correct because an examiner may make a new ground of rejection of claims added

after final. Petitioner concludes that answer (E) is incorrect and maintains that answer (C) is correct.

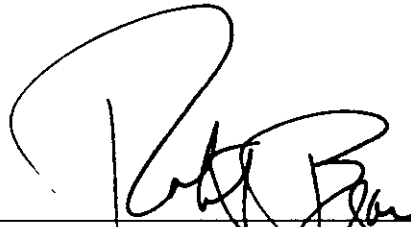
Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that there is no requirement to claim foreign priority in the declaration or oath, 37 C.F.R. § 1.63(c) states that the oath or declaration in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55 must identify the foreign application for patent or inventors certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. Petitioner states that this requirement is not a claim for foreign priority, but such a listing is inherently a claim for foreign priority. As to (C), 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy